

REMARKS

The Office Action mailed November 4, 2002 (Paper No. 13) in the above-identified application set a three-month shortened statutory period for reply expiring February 4, 2003. The period for reply is extended three months to May 4, 2003, pursuant to the Petition for Extension of Time under 37 C.F.R. 1.136(a) submitted herewith. This response is therefore timely filed.

Claims 1 and 14-35 are in the application.

New Claim 36 corresponds to dependent Claim 16 written in independent form.

Claims 1 and 14-35 are rejected under 35 U.S.C. § 112, first paragraph, on the grounds that Applicants do not teach what is encompassed by “consisting essentially of” and how it applies to the claimed invention. The rejection is believed overcome by the instant amendment of claims 1-20 whereby the language objected to “consisting essentially of” is replaced by “containing”. Accordingly, the rejection under 35 U.S.C. § 112 should be withdrawn.

Claims 1 and 14-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagawa et al (US 4,963,387); Krotkiewski et al (EP 0 291 578); and Deveau et al (EP 636 321) on the grounds set forth in previous Office Actions (Paper Nos. 6 and 9). The Examiner maintains that Nakagawa et al disclose a salt substitute comprising sodium chloride, potassium chloride, magnesium, and calcium (see entire patent, especially the claims), and also disclose the use of other additives such as magnesium phosphate, calcium phosphate, magnesium citrate, citric acid, and ascorbic acid (see columns 3 and 4); that Krotkiewski et al disclose a table salt comprising sodium chloride, potassium chloride, calcium, and magnesium (see entire document), and also disclose restricted consumption of salt for health reasons including hypertension (see column 1); and that Deveau et al disclose a salt composition comprising sodium chloride and at least two salts from a group comprising magnesium chloride, calcium chloride, and potassium chloride (see abstract). The Examiner urges that, in the absence of a showing of unexpected results, the amounts claimed are merely a matter of choice and well-within the skill of the art. At most, the amounts are seen merely as optimization. Further, the Examiner calls attention to *In re Levin* 84 USPQ 232, specifically pointing to the position previously taken by the court that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients,

or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function.

Applicants respectfully submit that the fact situation in Levin differs significantly from the fact situation at bar. The Levin invention related to a spreadable food product used as a butter substitute. Although reportedly no single reference showed all of the ingredients and steps set forth in the claims, the combined references were deemed to disclose or suggest each and every ingredient of the product and step of the method defined by the claims, and the court concluded that Levin had failed to establish that his claims defined a patentable composition of matter that was superior or materially different from the prior art. In other words, Levin combined ingredients and employed methods deemed to be disclosed in the combined prior art references to produce a butter substitute that did not differ in a significant way from known butter substitutes. Applicants in the instant case, on the other hand, have produced a salt substitute that does differ from and is superior to known salt substitutes. It is beyond peradventure that the sole purpose of salt substitutes is to reduce to the extent possible the dietary intake of sodium chloride. In that context, it would be clear to one of ordinary skill that the art had sought palatable salt substitutes containing the minimum amount of sodium chloride, and that in view of the numerous prior art disclosures referred to at pages 5-7 of Applicants' specification as well as the cited Krotkiewski and Deveau references, a palatable sodium chloride/potassium chloride salt substitute required a minimum of about 40% sodium chloride. Applicants have surprisingly found that by partially replacing the sodium chloride of prior art salt substitutes with calcium salts it is possible to obtain a composition with significantly reduced sodium chloride content and yet that retains a taste and salting power similar to common table salt. This is not a difference without effect. In fact, the difference goes to the heart of the sole beneficial purpose of salt substitutes, which is to minimize the sodium chloride content in a palatable composition. Thus, Applicants' invention provides a salt substitute of acceptable saltiness and palatability and with the clear health benefit of significantly reduced sodium chloride content compared

to known salt substitutes, and does so in a manner neither taught nor suggested by the prior art. Thus, nothing in the prior art references referred to by Applicants or cited by the Examiner would teach or suggest partially replacing the sodium chloride in a sodium chloride/potassium chloride salt substitute with a calcium salt to reduce the sodium chloride content to 15% - 25% while retaining acceptable taste and salting power. In fact, it is clear from those references that, at the time the instant invention was made, it was recognized in the art that a palatable sodium chloride/potassium chloride salt substitute required a minimum of about 40% sodium chloride. To ignore this implicit teaching amounts to a failure to consider what the references would have collectively suggested to one of ordinary skill (*In re Ehrreich* 200 USPQ 504).

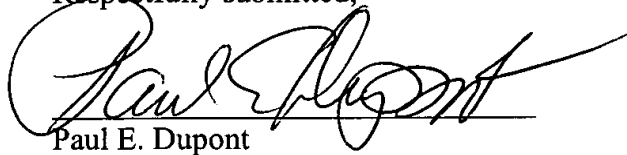
Nakagawa et al. have found that when whey mineral is used with potassium chloride and other alkali metal salts or with a combination of an alkali metal salt and an alkaline earth metal salt, the resulting substance has an enhanced salt taste and yet the bitter, puckery or discomforting taste tends to be masked. Thus, whey mineral is a critical ingredient of the Nakagawa compositions. Without it, the aforementioned salt substitute compositions have an irritating, bitter, or discomforting taste. Indeed, all compositions described in the Nakagawa specification and claims (specifically relied upon by the Examiner) contain whey mineral. Thus, the Nakagawa reference teaches the necessity of adding whey mineral to salt substitute compositions to enhance saltiness and mask the unpleasant taste of potassium chloride, and therefore, teaches away from Applicants' sodium chloride/potassium chloride salt substitute compositions in which the sodium chloride content is significantly reduced while retaining acceptable taste and saltiness by partially replacing the sodium chloride with a calcium salt. Clearly, there is nothing in the Nakagawa reference that would have suggested Applicants' invention. To characterize Nakagawa patent as teaching a salt substitute containing sodium chloride, potassium chloride, magnesium and calcium while ignoring that Nakagawa et al teach that whey mineral is the critical element of the composition is not a fair reading of the reference as a whole and does not accurately represent what the reference conveys to one skilled in the art. It is well settled that it is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from a reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what the reference fairly suggests to one of ordinary skill in the art.

In view of the foregoing, it is submitted that Applicants' invention would not have been either taught or suggested by a fair reading of the cited references as a whole, and accordingly, the instant claims define a patentable composition that is both materially different from and clearly superior to the prior art compositions. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

There being no remaining issues, this application is believed in condition for favorable reconsideration and early allowance, and such actions are earnestly solicited.

Dated: 4/29/03

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Paul E. Dupont", is written over a horizontal line.

Paul E. Dupont

Registration No. 27,438

Sanofi-Synthelabo Inc.
Patent Department
9 Great Valley Parkway
P.O. Box 3026
Malvern, PA 19355
Tel.: (610) 889-6338
Fax: (610) 889-8799